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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,335

11/21/2005

Wendelin Egli

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EXAMINER

MATTER, KRISTEN CLARETTE

ART UNIT

PAPER NUMBER

3771

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,335	Applicant(s) EGLI, WENDELIN	
	Examiner KRISTEN C. MATTER	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 3/24/05 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Applicant is encouraged to add appropriate headers to the specification.

Claim Objections

Claim 1 is objected to because of the following informalities: in line 4, “the body surface” should be changed to --a body surface-- to avoid antecedent basis issues and in line 9, the reference character should be surrounded by parentheses when mentioned within the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation that the outer skin and spacing layer are “not connected to one another” in the last line. However, it is not clear how the two layers are not connected because the two layers are worn on the same body part and in the specification (paragraph 13) the two layers are disclosed as "connected by simply folding the outer skin inward." Thus, just because no additional connecting elements are needed to create the airtight seal does not mean that the two layers are “not connected” as recited in the claim, making the claim language unclear.

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1, line 6, positively claims the spacer "between the body surface and the outer skin." Human body parts are non-statutory subject matter and therefore cannot be positively claimed. Similarly, claim 5 positively claims "cover[ing] the entire body," claim 6 claims "trousers that extends above the hips," claim 8 claims trousers that "end underneath the thighs," and claim 9 claims covering "the upper body only." Examiner suggests adding appropriate "adapted to" or "configured to" language to the claims to overcome this rejection.

Claims 2-4, 7, and 10-16 are dependent on a rejected claim base and are therefore rejected for the same reasons outlined above with respect to claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger (US 2003/0032904) in view of Feather (US4,230,114).

Regarding claim 1, Egger discloses a fitness device in the form of an article of clothing comprising an airtight and elastic outer skin (11a) (paragraphs 1-2 and 31), a vacuum pump (15) for generating a partial vacuum between the wearer's body and the outer skin, and a spacer (10,11,20) between the wearer's body and the outer skin (paragraph 42), wherein the vacuum pump is a battery operated and can be carried along in a pouch (paragraph 47), and wherein the vacuum pump is connected to the fitness device (see Figures 2 and 4) by a vacuum hose (15a, 15b). Egger further discloses the spacer layer as a textile spacing layer (paragraph 42) that is at least partially cut into the same shape as the article of clothing (see Figure 2). Although Egger shows a vacuum hose leading to the device in the Figures (which implies there is some sort of connection mechanism for securing the two), Egger does not specifically mention a connection piece for connecting the pump to the device. However, Feather discloses a similar fitness device having an airtight elastic outer layer, a spacer, and a vacuum pump connected to the device via a connection piece (45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Egger's device with a connection piece as

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taught by Feather in order to ensure the vacuum hose was properly secured to the device for generating the vacuum.

Regarding claim 2, Egger discloses a textile material that is cage-like to produce regular spacing of the device from the user's body without creating high-pressure portions but is silent as to the material being knitted monofilament fibers. However, absent a critical teaching and/or showing of unexpected results from use of knitted monofilament fibers, examiner contends that the material of the cage-like spacer is an obvious design consideration to one of ordinary skill in the art depending on user preferences for comfort, temperature control, absorption properties, etc. See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960), in which the selection of a known material based on its suitability for its intended use supported a prima facie case of obviousness. Furthermore, it appears as though the device of Egger would perform equally well with knitted monofilament fibers for the cage-like spacer.

Regarding claim 3, Egger discloses sealing edges (4, 6) formed by the outer skin.

Regarding claims 5-9, Egger discloses the article can be a full body suit (paragraph 32), trousers that extend above the hips and end at the thighs (paragraph 33), on the upper body only (paragraph 46), or as ankle length trousers (see Figures 1-2).

Regarding claim 16, the modified Egger device only has one connection piece and vacuum hose. However, absent a critical teaching and/or showing of unexpected results from having more than one connection piece and hose, examiner contends that addition of additional connection pieces and hoses would have been an obvious design consideration to one of ordinary skill in the art as a mere duplication of working parts that would not patentably distinguish the invention over the prior art. Such a modification would allow the vacuum to be applied more

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evening over a larger area for example when using a full body suit. Additionally, there is nothing structurally that would prevent such a modification and it appears as though the device of Egger as modified by Feather would perform equally well with more than one vacuum hose/connection piece.

Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger and Feather as applied to claims 1-3, 5-9 and 16 above, and further in view of O'Neill (US 3,731,319). Egger discloses the spacing layer being the same shape as the device (see figure 2) but is silent as the specifics of the seals (4,6) or how the spacing layer and skin cooperate to form an airtight seal. However, O'Neill discloses a pressurized body suit with airtight seals (27, 28) formed by folding an elastic layer over upon itself (see Figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the Egger device seals to be folded seals as taught by O'Neill because such seals are well known and commonly used in the art for creating good airtight seals in body suits and it would allow some user preference in determining the overall length of the suit on a wearer's neck and limbs for example. Furthermore, it appears as though the device of Egger would perform equally well with folded seals. By simply folding the skin over as taught by O'Neill, the layers would not be connected as best understood by the examiner.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger and Feather as applied to claims 1-3, 5-9 and 16 above, and further in view of Hum et al. (US 2003/0122655). Egger is silent as to sensors on the device for determining body parameters

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of the wearer. However, Hum et al. discloses an article of clothing with sensors for acquiring information such as temperature and biological information (paragraph 7) that is sent to a portable data collection device (paragraph 7 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added sensors to the modified Egger device in order to monitor a wear's bodily functions to assess workout performance or effectiveness for example. What type of sensors are added to the device (i.e., conductivity, temperature, breathing rate, heart rate, etc.) are considered an obvious design consideration to one of ordinary skill in the art depending on the type of exercises being done, a desired treatment plan for a presented condition, etc. Furthermore, it appears as though the device of Egger would perform equally well with sensors integrated into the device.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stockwell is cited to show another body suit with sealing edges formed by folding and Thornton is cited to show a pressurized pant with multiple vacuum hoses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771